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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/055,393

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EXAMINER

OSBORNE, MATTHEW C

ART UNIT

PAPER NUMBER

3694

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/055,393	Applicant(s) SMIRNOFF ET AL.	
	Examiner Matthew Osborne	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20011113</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the first Office Action on the merits for Application 10/055393.

Claims 1-33 have been examined.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 7, 9-12, 19, 22, 24-26, 28-31, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Weissman (US 6353811 B1).

3. Re Claims 1-2, 7, 9-12, 19, 22, 24-26, 31, and 33, Weissman teaches a credit card billing system comprising:

- [Claim 1, 31 (*medium*), and 33] receiving information associated with a customer's credit card transaction (see at least Column 7, Lines 5-13, receipt at the "central processing location"); and
- arranging through a communication network for invoice-based billing information associated with the credit card transaction to be provided via a customer device (see at least Column 5, Lines 31-48, using the "programmable transaction card" for each invoiced transaction).

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- [Claim 2] wherein the invoice-based billing information includes a project identifier that the customer has associated with the transaction (see at least Abstract, "sub-accounts specifically designated by the cardholder").
- [Claim 7] sorting the invoice-based billing information on an invoice basis (see at least Figure 2-A, invoices for each user account).
- [Claim 9] receiving customer notation information from the customer device (see at least Abstract, "cardholder electronically enters the sub-account to which the expenditure is to be allocated with the use of an electronic device"); and
- storing the customer notation information in association with the invoice-based billing information (see at least Abstract, "data processing system allocates to each designated sub-account all expenditures specified").
- [Claim 10] retrieving the customer notation information (see at least Abstract and Figure 2-A, inherent in creating "monthly or other period billing statements" for each sub account); and
- arranging for the customer notation information to be provided via the customer device (see at least Abstract, "cardholder electronically enters the sub-account to which the expenditure is to be allocated with the use of an electronic device").
- [Claim 11] wherein the customer notation information comprises a notation code (see at least Abstract, where notation code is the sub-account identifying code).
- [Claim 12] wherein a plurality of buyers are associated with the customer, and the invoice-based billing information includes a buyer identifier (see at least Figure 2-A).

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- [Claim 19] arranging for the customer to provide payment on an invoice basis (see at least Column 4, Lines 21-24, "method for allocating payments by a credit cardholder ... to the sub-accounts designated by the cardholder").
 - [Claim 22] receiving invoice-based allocation information associated with a payment amount (see at least Figure 2-B, payments directed to individual sub-accounts invoiced).
 - [Claim 24] wherein the received information includes at least one of: (i) a credit card account identifier, (ii) a merchant identifier, (iii) an invoice date, (iv) a project identifier, (v) an invoice amount, and (vi) an item description (Project Identifier: see at least see at least Column 7, Lines 5-13, receipt at the "central processing location" of the designated sub-account by identifier).
 - [Claim 25] wherein the provided information includes at least one of: (i) a customer identifier, (ii) a customer name, (iii) a customer address, (iv) a credit card account identifier, (v) a merchant identifier, (vi) a merchant name, (vii) a merchant address, (viii) an invoice date, (ix) an invoice identifier, (x) an invoice amount, (xi) an invoice balance, (xii) an invoice status, and (xiii) an item description (Customer Name: see at least Figure 2-A).
 - [Claim 26] wherein the customer device comprises at least one of: (i) a personal computer, (ii) a portable computer, (iii) a personal digital assistant, and (iv) a wireless telephone (PC: see at least Column 2, Lines 44-48).
4. Re Claims 28-30, Weissman teaches a credit card billing system comprising:

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- [Claim 28] a processor (see at least Figure 4, “central processing location 24” which, being a computer, inherently has a processor); and
- a storage device in communication with said processor and storing instructions (see at least Figure 4, “central processing location 24” which, being a computer, inherently has a storage medium containing “an integrated software package,” Column 7, Lines 9-10, which achieves the method taught therein) adapted to be executed by said processor to:
 - receive information associated with a customer's credit card transaction (see at least Column 7, Lines 5-13, receipt at the “central processing location”), and
 - arrange through a communication network for invoice-based billing information associated with the credit card transaction to be provided via a customer device (see at least Column 5, Lines 31-48, connecting with the “programmable transaction card” for each invoiced transaction).
- [Claim 29] wherein said storage device further stores at least one of: (i) a customer database, and (ii) an invoice database (Invoice Database: see at least Column 9, Lines 47-51, where “cumulative expenditures, interest accruals and payment information,” over an “annual or any other time period basis” constitutes a database of invoice information which is inherently stored in the “central processing location”).
- [Claim 30] a communication device coupled to said processor and adapted to communicate with at least one of: (i) a merchant device, (ii) a credit card account

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device, (iii) an invoice controller, (iv) a transaction processing system, and (v) a customer device (Customer Device: see at least Figure 4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-5, 8, 13, 15-17, 20-21, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weissman ('811) in view of Remington et al. (US 6070150).

7. Re Claims 3-5, 8, 13, 15-17, 20-21, 23, and 27, Weissman teaches the method of Parent Claim 1, *supra*. Weissman does not teach the limitations of Dependent Claims 3-5, 8, 13, 15-17, 20-21, 23, and 27. However, Remington teaches an electronic bill presentment and payment system comprising:

- [Claim 3] transmitting to an electronic mail address associated with the customer a message indicating that the invoice-based billing information is available (see at least Column 8, Lines 17-22).
- [Claim 4] wherein the message includes an identifier adapted to be used by the customer to retrieve the invoice-based billing information (see at least Column 8, Lines 24-28, where the message's link is the identifier adapted to retrieve billing information).
- [Claim 5] wherein said transmitting is performed at least one of: (i) on an invoice basis, (ii) on a periodic basis, and (iii) in response to a request by the customer

(Invoice Basis: see at least Abstract, "The biller submits the bill" wherein each bill sent is an individual invoice).

- [Claim 8] arranging for statement-based billing information to be provided via the customer device (see at least Column 9, Lines 39-58, "past payments," "itemized details," "account number," etc, which is all displayed on the customer's computer).
- [Claim 13] wherein said arranging is performed without sending the invoice-based billing information via postal mail (see at least Column 15, Lines 59-61, "Paper bills, conventional mail services, and envelop[e] opening and encoding tacks[sic] are completely eliminated").
- [Claim 15] transmitting to the customer device at least one of: (i) enrollment confirmation information, (ii) reminder information, (iii) payment schedule information, (iv) payment confirmation information, and (v) payment history information (Payment Confirmation/History: see at least Figures 8 & 9, Items 216-224).
- [Claim 16] receiving from the customer device at least one of: (i) enrollment information, and (ii) account adjustment information (Adjustment Information: see at least Abstract, "The bill can then be automatically or manually adjusted to reflect any disputed amounts").
- [Claim 17] wherein the customer is associated with a plurality of users, and further comprising (see at least Column 1, Lines 24-26, "consumer" is used

throughout to represent both a typical person consuming goods and services as well as a business consuming goods and services.”):

- o controlling a user's access to the invoice-based billing information (see at least Column 15, Lines 18-28, “digital signatures can be used as a means for authenticating the parties”).
- [Claim 20] wherein the payment is provided with at least one pre-stored bank account identifier (see at least Column 6, Lines 5-8, “The payee ... is automatically designated as the biller so that payment back to the biller’s account is guaranteed.”).
- [Claim 21] wherein the payment is provided with a bank check sent via postal mail (see at least Figure 1).
- [Claim 23] wherein said arranging for the customer to provide payment comprises scheduling a future payment (see at least Abstract, “specifying the amount to be paid ... and the date for the payment” where said date is in the future).
- [Claim 27] wherein the communication network comprises at least one of: (i) an Internet protocol network, (ii) the Internet, (iii) a public network, (iv) a proprietary network, and (v) a wireless network (see at least Abstract, “configured for use over an electronic network, such as the Internet”).

It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the bill presentment and payment system of Remington into the credit card billing system of Weissman in order to allow each biller to “directly control

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the format for presenting the [individual] bill, the format for receiving any remittance information,” (Remington, Column 5, Lines 30-33) and to improve the security of transactions between host and client through secure channel communications.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weissman ('811) in view of Verderamo et al. (US 6230145 B1).

9. Weissman does not teach printing. However, Verderamo teaches a method for providing bank card transaction data which includes the ability to print downloaded statement information (see at least Figure 33A, “Tips for Printing” link). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the output features of Verderamo into Weissman in order to allow users to make hard copies of electronic reports received and in order to create an “all-in-one suite of account management tools” (Verderamo, Column 1, Lines 46-47).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weissman ('811) in view of Remington ('150) as applied to Claim 3 above, and further in view of Guthrie et al. (US 2002/0052841 A1).

11. Weissman in view of Remington does not teach using multiple email addresses. However, Guthrie teaches an electronic payment system which provides an account update interface which “allows for ... management of user’s email addresses (multiple)” see Paragraph 46 of the Detailed Description). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the electronic payment system of Guthrie into the credit card billing system of Weissman in view of Remington

in order to allow customers to add email addresses to an existing account after those addresses have been billed (see Guthrie, Paragraph 48 of the Detailed Description).

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weissman ('811) in view of Remington ('150) as applied to Claim 17 above, and further in view of Magary et al. (US 2001/0056387 A1).

13. Weissman in view of Remington does not teach one user being a customer service representative. However, Magary teaches a method for providing financial transaction data via the Internet wherein "a first type of access is performed by the customer service function of the brokerage" where a "customer service representative ID" is required (see Paragraphs 21-22 of the Detailed Description). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Magary into the credit card billing system of Weissman in view of Remington in order to "respon[d] to a query from the [user], or for normal maintenance purposes" (Magary, Paragraph 22 of the Detailed Description).

14. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weissman ('811) in view of Verderamo ('145).

15. Weissman teaches a credit card billing system comprising:

- receiving information associated with a customer's commercial credit card transaction (see at least Column 7, Lines 5-13, receipt at the "central processing location"), the received information including a project identifier (see at least Abstract, "sub-accounts specifically designated by the cardholder"),

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- transmitting invoice-based billing information, including the project identifier *to the customer* (see at least Figure 2-A, transmission through statement), and
- arranging for the customer to provide payment on an invoice basis (see at least Column 4, Lines 21-24, "method for allocating payments by a credit cardholder ... to the sub-accounts designated by the cardholder").

Weissman does not teach transmitting an electronic message and Web site link to the user or transmitting billing information via the Web site. However, Verderamo teaches a method for providing bank card transaction data comprising:

- transmitting to an address associated with the customer (see at least Figure 2, the IP address of the user's computer connected to the Internet) an electronic message indicating that invoice-based billing information is available, the message including a link to a Web site (see at least Figure 9, a message showing the merchant accounts available for viewing which is linked to a Web site for that account), and
- transmitting the invoice-based billing information, including project identifier, via the Web site and a customer device (see at least Figures 10-43, specifically 23, wherein the Terminal ID is a "project identifier", and the Web site is displayed on the client's computer, the "customer device").

It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the web-interface characteristics of Verderamo into the credit card billing system of Weissman in order to create an "all-in-one suite of account management tools" accessible by customers on the Internet.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chancey et al. (US 5842185) teaches a method and system for electronically tracking financial transactions.

Schrader et al. (US 5903881) teaches a personal online banking with integrated online statement and checkbook user interface.

Kolling et al. (US 5963925 A) teaches an electronic statement presentment system.

Powar (US 6285991 B1) teaches a secure interactive electronic account statement delivery system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew C. Osborne
Examiner
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PRIMARY EXAMINER